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Attorney Docket 20030909

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of James T. Doubet

Serial Nbr: 10/668,533

Filed: September 23, 2003

For: **ENABLING COUNTRY OF ORIGIN LABELING AND VERIFICATION
FOR LIVESTOCK PRODUCTS**

Art Unit: 3609

Examiner: Oluseye Iwarere

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby requests review of the Final Rejection in the Office Action mailed January 9, 2009 in the above-identified Application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

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GROUND OF REJECTION PRESENTED FOR REVIEW

Rejection of Claims 1 - 19 and 21 under 35 U.S.C. §102(e) as being unpatentable over U. S. Patent Publication 2003/0177025 to Curkendall et al. (hereinafter, "Curkendall"), according to the Office Action mailed January 9, 2009 (hereinafter, "the Office Action").

ARGUMENT

Applicant reserves the right to present additional arguments, and in particular to argue separate patentability of the dependent claims, if this Petition is denied.

MPEP §706.02, paragraph V, states with regard to an anticipation rejection under 35 U.S.C. §102, "... the reference must teach every aspect of the claimed invention either explicitly or impliedly" (emphasis added). Applicant also notes the holding of the Federal Circuit in *Motorola, Inc. v. Interdigital Technology Corp.*, 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997), which stated

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990) ("[T]he [prior art] reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it." (citations omitted)). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. (emphasis added)

Referring first to independent Claim 1, when analyzing the "assigning a unique passport identifier ..." claim element on lines 5 - 6, the Office Action cites Curkendall's para. [0020] as teaching "... These devices typically produce ... a unique ... code ...". However, when taken in context of surrounding paras. [0019] and [0021] - [0025], it is clear that para. [0020] is referring to devices such as RFID devices that always emit the same device-specific code. Thus, a particular RFID device would emit its device-specific code for every transaction in which that device participates. This repeated issuing of a particular code is different from "thereby providing a

unique identification of the transfer” as recited on lines 5 - 6 of Claim 1.

Furthermore, the cited para. [0020] is silent on a “unique passport identifier” (Claim 1, line 5, emphasis added).

The Response to Arguments section states, with regard to the “assigning” claim element, “... each transfer to PEN-1 would be unique, to each animal ...”. However, it is clear from the antecedent on lines 3 - 4 that the assigned “unique passport identifier” recited on lines 5 - 6 is for a transfer of “animals” – that is, a plurality of animals, not an individual animal.

The Office Action cites paras. [0022] and [0029] as teaching the “repeating ...” element on lines 7 - 10 of Claim 1. With reference to the cited para. [0022], the Office Action states “via there is a need to provide ... individual animal identification ...” (emphasis added). Applicant agrees that this is what is discussed in para. [0022]. However, this is not what Applicant has claimed. Instead, Applicant’s claim language recites providing a unique identifier of a transfer (see the antecedent on Claim 1, lines 3 - 6), not of an animal. Furthermore, providing “individual animal identification throughout the production cycle” in no way teaches creating another animal passport (i.e., “repeating the creating”) and assigning another unique passport identifier (i.e., “repeating the ... assigning”) for each subsequent transfer.

With reference to the cited para. [0029], the Office Action states that this para. “discusses complete source verification and performance databases for all key livestock events”. Applicant notes, however, that para. [0029] is discussing health records of animals, and is silent as to “subsequent transfer”, “most-recent previous transfer”, and “also records [i.e., in addition to a unique passport identifier assigned to the “subsequent” transfer] the unique passport identifier assigned to each most-recent previous transfer ...” (emphasis added). Applicant also respectfully

submits that the citation of apparently-unrelated paras. [0022] and [0029] as supposedly teaching the “repeating ...” claim element demonstrates an impermissible hindsight approach, whereby the Examiner “read[s] into the prior art reference teachings that are not there”, in violation of the above-quoted *Motorola, Inc.*

Referring next to independent Claim 16, the Office Action cites para. [0205] when analyzing the “a unique identifier associated with each transfer of a group of animals” (Claim 16, line 3), stating “... to provide unique identification for each animal”. Applicant respectfully notes that para. [0205] is silent as to “transfer” and to “group of animals”. Clearly, para. [0205] does not disclose a unique identifier associated with a transfer, nor does it disclose “a” (i.e., single) unique identifier for a transfer of a group of animals. Instead, as noted in the Office Action, para. [0205] is discussing unique per-animal identification, which is not recited in Applicant’s Claim 16.

For the “... recording the unique identifier of each of the transfers, along with a specification of how many animals are in the group ...” (Claim 16, lines 4 - 6, emphasis added), the Office Action cites para. [0027], and basically states that different databases exist for different stages of the production cycle. Applicant does not recite anything in Claim 16 about multiple databases. In the Response to Arguments section, the Office Action further cites para. [0032] and Fig. 63. Applicant respectfully notes that the cited para. [0027], [0032], and Fig. 63 are silent as to recording “how many animals are in the group” and an identification of transferor(s) and also of transferee(s).

For the “linkage ...” element recited on lines 7 - 9 of Claim 16, the Office Action cites para. [0395], which refers to an animal ID that is common through changes of ownership. Claim 16 does not claim animal IDs; it recites IDs for transfers of animals. Para. [0395] is silent on IDs for

transfers, and in particular, is silent on “a specified association between a new unique identifier associated with each subsequent transfer and the unique identifier of the prior transfer” (emphasis added). How, for example, is an animal ID that does not change supposedly equated to transfer IDs that clearly are changing/different from one transfer to the next transfer?

Referring next to independent Claim 18, the Office Action cites para. [0395] for the “linking ...” claim element recited on lines 6 - 8. Refer to the discussion of the “linkage ...” claim element of Claim 16, above; this discussion applies in an analogous manner to the “linkage ...” element of Claim 18.

Referring finally to independent Claim 21, the Office Action cites Fig. 63 when analyzing the claim language on lines 7 - 8 thereof, stating “fig. 63 depicts count”. Applicant respectfully disagrees: the word “count” does not appear in Fig. 63. Applicant notes that the claim language further recites “a location of the transfer”; however, no discussion thereof is provided in the Office Action.

For the “specifying ... the unique passport identifier associated with any previous passport document ...” as recited on lines 9 - 11 of Claim 21, the Office Action cites Fig. 63, stating that it “depicts the unique event ID”. Applicant respectfully notes that the antecedent at lines 4 - 5 of Claim 21 recites that the passport document “has associated therewith a unique passport identifier”, and the “unique passport identifier” recited on lines 9 - 11 is clearly a different unique identifier for a different passport document. Where is this use of two different passport identifiers illustrated in Fig. 63?

The Office Action cites Fig. 63 as teaching the “creating an entry ...” claim element on

lines 16 - 20 of Claim 21, stating “fig. 63 depicts creating an entry in the database for each of the events”. Applicant respectfully submits that this is reading teachings into Fig. 63 which are not there, in violation of the above-quoted *Motorola, Inc.* Fig. 63 is silent as to recording (at least) the count, description, location, and unique identifier associated with the previous passport document.

For the “using ...” claim element recited on lines 22 - 25 of Claim 21, the Office Action cites Fig. 63 and para. [0131], stating that these “discuss entries of core events including origin”. However, Fig. 63 does not contain the word “origin”, and para. [0131] simply says that “origin” is a core event. This in no way teaches “whether a country of origin claim can be made” (Claim 21, lines 22 - 23, emphasis added) nor does it teach “by comparing, in each of the entries [as recited in the antecedent on lines 16 - 20] ... to the particular country”. In fact, neither Fig. 63 nor para. [0131] describes any type of “comparing”.

In view of the above, Applicant respectfully submits that Curkendall does not teach every aspect of Applicant’s claimed invention as recited in Claims 1, 16, and 21, in violation of the above-quoted MPEP §706.02, paragraph V. Curkendall also does not disclose “each and every element of the claim with sufficient clarity to prove its existence in the prior art”, in violation of the above-quoted *Motorola, Inc.* (emphasis added). For at least these reasons, Claims 1, 16, and 21 are deemed patentable over Curkendall. In view of the patentability of independent Claims 1 and 16, Applicants respectfully submit that their dependent Claims 2 - 15 and 17 are also patentable over the cited references.

Accordingly, Applicant respectfully requests that the rejection in the Office Action be reversed by the appeal conference prior to the filing of an Appeal Brief.